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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/894,904  | 06/29/2001  | Steven C. Monroe     | 06978.0105-00000    | 4655             |
| 23838   | 7590        | 11/03/2004           | EXAMINER            |                  |
| KENYON & KENYON<br>1500 K STREET, N.W., SUITE 700<br>WASHINGTON, DC 20005 |             |                      | CHEN, TE Y          |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2161                 |                     |                  |

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                   |
|------------------------------|-----------------|-------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)      |
|                              | 09/894,904      | MONROE, STEVEN C. |
|                              | Examiner        | Art Unit          |
|                              | Susan Y Chen    | 2161              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 June 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 21-50 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 21-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

***Response to Amendment***

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/02/2004 has been entered.

This office action is in response to amendment filed on 06/02/2004.

Claims 21-50 are pending for examination, claims 21, 31 and 41 have been amended, claims 1-20 have been canceled.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-50, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,769,031 issued to Bero (hereinafter referred as Bero '031).

Claim 21:

Bero '031 discloses:

A whois database [e.g., Col. 7, line 49 – col. 8, line 17; Fig(s). 3A-11 and associated texts], comprising:

- extracting a plurality of unique identifiers from an audit file, each unique identifier corresponding to a modified domain name record within a registrar database [e.g. col. 20, lines 43-61; Fig(s). 8-9 and associated texts] ; and for each unique identifier:
  - determining whether a first domain name record that corresponds to the unique identifier exists within the registrar database, if the first domain name record exists, retrieving the first domain name record from the registrar database [e.g., Steps: 905, 910, 915, Fig. 9];
  - determining whether a second domain name record that corresponds to the unique identifier exists within the who is database, if the second domain name record exists, retrieving the second domain name record from the whois database [e.g, steps: 920, 925, Fig. 9];
  - comparing the first domain name record to the second domain name record [e.g., steps: 950, 960, 970, Fig. 9]; and

updating the second domain name record, within the whois database, based on the first domain name record [e.g., steps: 925, 930, 980, Fig. 9; step, 855, Fig. 8].

Claim 22:

Bero '031 further discloses:

The cited feature “deleting a second domain name record if the first corresponding domain name record does not exist”. [e.g., the step 980, Fig. 9].

Claim 23:

Bero '031 further discloses:

The cited feature “adding a first domain name record to the whois database if the second corresponding domain name record does not exist”. [e.g., col. 9, lines 2-25].

Claim 24:

The cited feature – discarding duplicate unique identifiers from the plurality of unique identifiers -- is the nature property of unique identifier.

Claim 25:

The cited features – modified domain name record consists of an added domain name record, a deleted domain name record and changed domain name record – are inherent for any modification processing performed on a domain name data item.

**Claim 26:**

Bero '031 further discloses:

The cited features - using an indicator to indicate the type of add, delete and change processing corresponding to a unique identifier of an audit file. [e.g., the updated type indicator 365, Fig. 3B].

**Claim 27:**

Bero '031 further discloses:

The audit file includes modified domain name information associated with each unique identifier [e.g. Fig. 3B and associated texts].

**Claim 28:**

Bero '031 further discloses:

the plurality of unique identifiers are associated with a time period [e.g., claim 17].

**Claim 29:**

Bero '031 further discloses:

tagging the audit file to identify previously extracted unique identifiers [e.g. col. 2, lines 7-25].

Claim 30:

Bero '031 further discloses:

The whois database is a copy of registrar database [e.g. col. 11, lines 5-16].

As to claims 31-50, these claims recite the same features as claims 21-30 in form of computer system and computer-readable program product, hence are rejected for the same reason.

### ***Response to Arguments***

Applicant's arguments with respect to claims 21-50 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gardos et al. (U.S. Patent No. 6,745,248) which discloses a system for analyzing domain name registrations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahić can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen  
Examiner  
Art Unit 2161



October 27, 2004

UYEN LE  
PRIMARY EXAMINER